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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Plow) Art Unit: 3622
Serial No.: 09/922,182) Examiner: Myhre
Filed: August 2, 2001) STL9-2000-0035-US1
For: SYSTEM, METHOD, AND COMPUTER PROGRAM PRODUCT FOR STORING INTERNET ADVERTISEMENTS AT A USER COMPUTER) October 8, 2007 750 B STREET, Suite 3120 San Diego, CA 92101

REPLY BRIEF

Commissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

This REPLY brief responds to the Examiner's Answer dated October 2, 2007.

The Answer brushes off the claim limitation of "advertising history window" as not being entitled to any patentable weight since it is a mere "title", Answer, page 5, lines 5 and 6. Quite the contrary; the modifiers "advertising history" that precede the noun "window" mean something, and on its face the claim is clear - the window cannot be a window displaying anything as the conferees' position otherwise would require, but only advertising history as explicated by the claim. Modifiers in the body of a claim cannot be dismissed so facilely. The rejections merit reversal.

The Answer then somewhat incongruently alleges that col. 4, lines 31-35 of Lemole "disclose such a window", quoting Lemole apparently incognizant of the fact that what is being quoted from Lemole is not a window at all but rather a teaching of how to construct an advertising page. This teaching does not address

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advertisements that are saved at the user computer as claimed, but rather an "advertising page" on a server that subsequently can be accessed by the user computer, see col. 6, lines 20-45.

The Answer continues to attempt to transmogrify the apple of Lemole into the orange of the claims by alleging that this advertising page, being pushed to the user computer, meets the limitation of allowing a user to filter previously displayed advertisements, so that only advertisements corresponding to one or more user selected attributes are eligible for display, but this is nonsensical. The user does not filter the ads in the page from Lemole's server, the server does.

The Answer continues to allege that the user of Lemole gets to filter the ads as claimed by inputting the user's demographics, but as pointed out in the Appeal Brief this is a false syllogism. The user has absolutely no control over the ads that the server sends back based on the demographics. The server can use any algorithm it chooses to select the ads wholly out of the control of the user, which can meet Claim 1 only if the adjective "reasonable" is erased from the stricture to accord claims their broadest interpretation during prosecution. Which it hasn't been, see, e.g., In re Buszard, CAFC precedential case no. 2006-1489, decided September 27, 2007.

The response of the conferees on the bottom of page 6 of the Answer to Appellant's observation that the relied-upon scroll bar in Lemole is not for scrolling through ads in an ad history window but rather through a registration form is even weaker. Specifically, the Answer feebly alleges something about "inherency" without evidently understanding that to be inherent, the ads must *necessarily* appear in the relied-upon registration page, which they don't. The same feeble and, more importantly, legally incorrect response to Appellant's arguments concerning Claim 6 has been lodged on page 7 of the Answer.

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The bottom of page 7 of the Answer lodges allegations regarding what is "known" in the art to address Appellant's observation that Claim 7 requires that the server transmit the Internet advertisements to the user computer while the user is engaged in activity other than requesting the advertisements, a limitation heretofore not discussed. One problem with the allegations (which are new in prosecution) is that they arrive unaccompanied by evidence as is otherwise required by KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727 (2007), dispository dooming the case against Claim 7. Because these allegations are mere examiner argument without any evidentiary support, they do not warrant being addressed on their technical merits.

The conferees conclude with the somewhat bizarre proposition that whether they are interpreting Claims 7-11 and 13-19 in accordance with the sixth paragraph of Section 112 is not a fit topic for appeal. Claim construction is central to this appeal because it is of necessity central to examination on the merits. Apparently the conferees wish to avoid addressing the legal points made in the Appeal Brief on this topic.

Respectfully submitted,


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